



3611

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/085,454
Applicant(s): David NELMS, Betty SCHICK, Kim WILSON and Roger C.
HOCHSCHILD
For: NON-RECTANGULAR SHAPED CREDIT CARD WITH CASE
Confirmation No.: 1815
Customer No.: 26116
Docket No.: 11677/00801 (DSC-7A)
Filed: February 27, 2002
Group Art Unit: 3611
Examiner: Cassandra Hope Davis

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being sent via facsimile to: (703) 872-9306, ATTN: Office of Petitions, on
July 27, 2005
Date of Deposit
Douglas A. Sorensen
Name of Applicant, Assignee, or Registered Representative

Signature
July 27, 2005
Date of Signature

Dear Sir:

THIRD RENEWED PETITION
TO CLAIM BENEFIT UNDER 35 U.S.C. § 120 OF A PRIOR COPENDING
NONPROVISIONAL APPLICATION UNDER 37 C.F.R. § 1.78(a)(3)

The Applicants hereby submit this third renewed petition under 37 CFR 1.78(a)(3). This renewed Petition is filed in response to the Decision on Petition Under 37 CFR § 1.78(a)(3) mailed July 1, 2005. In the Decision, the prior petitions were dismissed for failure to comply with the requirement of 37 CFR 1.78(a)(2)(i) that a nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed applications, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications.

The Second Renewed Petition was denied in a Decision on Petition dated July 1, 2005. In the Decision on Petition, it is stated that "a closer review of the two applications in question, application No. 10/085,454 and application No. 29/133,861, reveals that the two applications do not have an inventor in common. The inventors for application no. 10/085,454 are : Nelms, Schick, and Wilson. The inventor for application no. 29/133,861 is Hochschild." This is incorrect. Attached is a copy of the Amendment dated November 11, 2002, which added Hochschild as an inventor to application No. 10/085,454.

As stated in the Second Renewed Petition, the prior Amendment filed May 4, 2004, failed to state the relationship of Application No. 29/133,861, filed December 8, 2000, to the instant application. The first and second substitute amendments erroneously implied that the benefit of U.S. Provisional Application Serial No. 60/306,743 was being claimed under 35 U.S.C. §120. A third substitute Amendment is being submitted concurrently herewith. In the Third Substitute Amendment, the amendment to the specification now states that " This application claims the benefit under 35 U.S.C. §119(e) of U.S. Provisional Application Serial No. 60/306,743, filed July 20, 2001, which is incorporated herein by reference. This application also claims the benefit under 35 U.S.C. §120 of and is a continuation-in-part of Application Serial No. 29/133,861, filed December 8, 2000, now issued U.S. Patent No. D457,556." The only revisions to the amendment filed May 4, 2004, are these references to the prior applications and an explicit statement that new claims 50-52 are within the elected species of this application.

Applicants submit herewith copies of documents previously filed with the U.S. Patent and Trademark Office, including (1) an Amendment, Request and Fee To Add Original Erroneously Not Named Inventor in Non-Provisional Application Under 37 CFR § 1.48(a), having a mailing date of November 11, 2002; (2) Statement of Applicants in Support of Amendment To Correct Inventorship Under 37 CFR § 1.48(a); (3) Assent of Assignee to Correction and Addition of Inventors; (4) a true and correct copy of the original signed Declaration for Patent Application signed by inventor/applicants David W. NELMS, Betty M. SCHICK, Kimberly S. WILSON, and Roger C. HOCHSCHILD.

Because the Decision on Petition was based on an inaccuracy, Applicants hereby renew their petition in accordance with 37 C.F.R. § 1.78(a)(3) to claim the benefit, for this application,

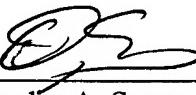
under 35 U.S.C. § 120, of prior copending application no. 29/133,861, filed December 8, 2000. Applicants request granting of this Petition to claim the benefit of the prior copending application. Applicants state that the entire delay between the date the claim for the benefit of the earlier application was due under 37 C.F.R. § 1.78(a)(2)(ii) and the date this claim is filed was unintentional.

Applicants previously submitted a check in the amount of \$1,280.00 for the surcharge fee required by 37 C.F.R. § 1.55(c)(1). Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By: 
Douglas A. Sorensen
Registration No. 31,570
Attorney for Applicant

DAS:

SIDLEY AUSTIN BROWN & WOOD LLP
717 N. Harwood, Suite 3400
Dallas, Texas 75201
Direct: (214) 981-3482
Main: (214) 981-3300
Facsimile: (214) 981-3400
May 20, 2005



I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on

11/11/02

Date of Deposit

Hugh A. Abrams, Reg. No. 31,937

Name of Applicant, Assignee or
Registered Representative

Hugh A. Abrams

Signature

Our File No. DSC-7A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
David W. Nelms et al.)
Serial No. 10/085,454)
Filing Date: February 27, 2002)
For: NON-RECTANGULAR SHAPED)
CREDIT CARD WITH CASE)
)

TRANSMITTAL FORM

Honorable Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicants submit the following documents herewith for filing in the above-identified application:

1. Amendment, Request and Fee to Add Original Erroneously Not Named Inventor in Non-Provisional Application under 37 CFR § 1.48(a), with attached check in the amount of \$130.00 for the fee required by 37 CFR § 1.17(i).

2. Statement of Applicants in Support of Amendment to Correct Inventorship
Under 37 CFR § 1.48(a).

3. Assent of Assignee to Correction and Addition of Inventors with attached
Statement under 37 CFR § 3.73(b).

4. Declaration for Patent Application, executed by all inventors.

5. Petition to Claim Benefit Under 35 U.S.C. § 120 of a Prior Copending
Nonprovisional Application Under 37 CFR § 1.78(a)(3), with attached check in the amount of
\$1280.00 for the fee required by 37 CFR § 1.17(t).

6. Supplemental Information Disclosure Statement and Form PTO 1449A
and copies of the cited references.

7. Stamped Return Postcard listing the above items.

The Commissioner is authorized charge any additional fees necessitated by this
filing to Deposit Account No. 18-1260.

Dated: November 11, 2002

Respectfully submitted,



Hugh A. Abrams
Reg. No. 31,937
Attorney for Applicants

Sidley Austin Brown & Wood
Bank One Plaza
10 S. Dearborn Street
Chicago, IL 60603
(312) 853-7017

Address all correspondence to:

Docket Administrator
SIDLEY AUSTIN BROWN & WOOD LLP
717 North Harwood, Suite 3400
Dallas, Texas 75201-6507
(214) 981-3300 (Main)
(214) 981-3400 (Facsimile)



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Hugh A. Abrams, Reg. No. 31,937

Name of Applicant, Assignee or
Registered Representative

Hugh A. Abrams

Signature

Our File No. DSC-7A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
David W. Nelms et al.)
Serial No. 10/085,454)
Filing Date: February 27, 2002)
For: NON-RECTANGULAR SHAPED)
CREDIT CARD WITH CASE)
)

**AMENDMENT, REQUEST AND FEE TO ADD ORIGINAL ERRONEOUSLY NOT
NAMED INVENTOR IN NON-PROVISIONAL APPLICATION UNDER
37 C.F.R. § 1.48(a)**

Honorable Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This amendment and request is to correct the incorrect original naming of the inventors in the declaration under 37 C.F.R. § 1.48(a) as set forth and filed on May 27, 2002.

Please add the following previously unnamed person as inventor of this application: Roger C. Hochschild

Filed concurrently herewith is a statement from each person being added as an inventor that the error in inventorship occurred without deceptive intention on his part. 37 C.F.R. § 1.48(a)(1). Also filed concurrently herewith is a declaration by each of the actual inventors as required by 37 C.F.R. § 1.63. Also filed concurrently herewith is written assent of the assignee.

Enclosed is a check in the amount of \$130.00 for the fee required by 37 C.F.R. § 1.17(i). The Commissioner is authorized charge any additional fees necessitated by this filing to Deposit Account No. 18-1260.

Dated: November 11, 2002

Respectfully submitted,



Hugh A. Abrams
Reg. No. 31,937
Attorney for Applicants

Sidley Austin Brown & Wood
Bank One Plaza
10 S. Dearborn Street
Chicago, IL 60603
(312) 853-7017

Address all correspondence to:

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717 North Harwood, Suite 3400
Dallas, Texas 75201-6507
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Name of Applicant, Assignee or
Registered Representative

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Our File No. DSC-7A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
David W. Nelms et al.)
Serial No. 10/085,454)
Filing Date: February 27, 2002)
For: NON-RECTANGULAR SHAPED)
CREDIT CARD WITH CASE)
)

**STATEMENT OF APPLICANTS IN SUPPORT OF AMENDMENT TO CORRECT
INVENTORSHIP UNDER 37 C.F.R. § 1.48(a)**

Honorable Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This statement of the applicants is being submitted in support of the amendment and request to correct the original naming of the inventors. In support of the amendment, the applicants state as follows:

1. A non-provisional application for patent entitled "Non-Rectangular Shaped Credit Card With Case," was filed on February 27, 2002. The application has been assigned U.S. Serial No. 10/085,454.

2. U.S. Serial No. 10/085,454, as filed, named David W. Nelms, Betty M. Schick and Kimberly S. Wilson (hereinafter the "Named Inventors") as inventors of the subject matter disclosed and claimed therein.

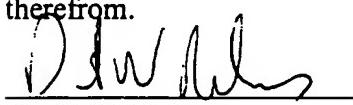
3. The subject matter of Serial No. 10/085,454, was the product of a joint development effort of the Named Inventors, who are employees of assignee Discover Financial Services, Inc., in Riverwoods, Illinois. That joint development effort also involved the contributions of Roger C. Hochschild, who was employed by Discover Financial Services, Inc. at the Riverwoods facility until March 29, 2001. Thereafter, Roger Hochschild was transferred to the parent company of assignee Discover Financial Services, Inc., and subsequently relocated to New York City, New York in June, 2001.

4. At the time the referenced patent application was filed on February 27, 2002, Mr. Hochschild was no longer working with the Named Inventors in Riverwoods, Illinois. On information and belief, the Named Inventors and Roger C. Hochschild state that Roger C. Hochschild had no knowledge of the referenced patent application until after it was filed on February 27, 2002. The failure to name Roger C. Hochschild as an inventor was without deceptive intent on the part of the Named Inventors and without deceptive intent on the part of Roger C. Hochschild.

5. After the referenced application was filed on February 27, 2002, the Named Inventors understood that Roger C. Hochschild should be named as an inventor of the subject matter disclosed and claimed in the referenced application and that the referenced

application should be amended to name Roger C. Hochschild as an inventor. The Named Inventors have been diligent in supporting the preparation and filing of the necessary amendment to correct inventorship.

6. The Named Inventors and Roger C. Hochschild individually declare that all of the statements made herein of their own knowledge are true and that all statements made on information and belief are believed to be true; and further that all statements made herein are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.



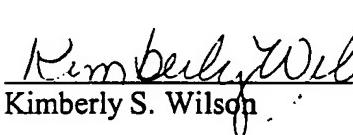
David W. Nelms

Date: 10/31/02



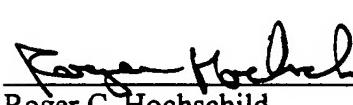
Betty M. Schick

Date: 10/31/02



Kimberly S. Wilson

Date: 10/31/02



Roger C. Hochschild

Date: 11-03-02



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11/11/02

Date of Deposit

Hugh A. Abrams, Reg. No. 31,937

Name of Applicant, Assignee or
Registered Representative

Hugh A. Abrams

Signature

Our File No. DSC-7A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
David W. Nelms et al.)
Serial No. 10/085,454)
Filing Date: February 27, 2002)
For: NON-RECTANGULAR SHAPED)
CREDIT CARD WITH CASE)
)

ASSENT OF ASSIGNEE TO CORRECTION AND ADDITION OF INVENTORS

Honorable Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Discover Financial Service, Inc., 2500 Lake Cook Road, Riverwoods, Illinois 60015, which is assignee by virtue of an assignment recorded on June 5, 2002, at Reel 012965, Frame 0679, hereby assents to the correction of inventorship filed herewith. A statement under 37 C.F.R. § 3.73(b) is attached.

Betty M. Schick
Signature
Betty M. Schick
(print name of person authorized to sign)



PTO/SB/96 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Discover Financial Services, Inc.

Application No./Patent No.: 10/085,454 Filed/Issue Date: February 27, 2002

Entitled: Non-Rectangular Shaped Credit Card With Case

Discover Financial Services, Inc., a corporation

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

- the assignee of the entire right, title, and interest; or
- an assignee of less than the entire right, title and interest.
The extent (by, percentage) of its ownership interest is _____ %

in the patent application/patent identified above by virtue of either:

A. [An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 012965, Frame 0679, or for which a copy thereof is attached.

OR

B. [A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

[Additional documents in the chain of title are listed on a supplemental sheet.

[Copies of assignments or other documents in the chain of title are attached.

[NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

11/8/02

Date

Betty M. Schick

Typed or printed name

Betty M. Schick

Signature

Vice President

Title



Case No. DSC-7A

DECLARATION FOR PATENT APPLICATION

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name; I believe that I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled **NON-RECTANGULAR SHAPED CREDIT CARD WITH CASE** the specification of which (check one): is attached hereto; was filed on February 27, 2002, as Application Serial No. 10/085,454, and was amended on (or amended through) _____ (if applicable) (and we hereby authorized our attorney, Hugh Abrams, to here insert the filing date and serial number of said application, as soon as it is known, Filed _____, Serial No. _____). I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, § 1.56(a). I hereby claim foreign priority benefits under Title 35, United States Code, § 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)

Priority Claimed

Yes No

(Number) (Country) (Day/Month/Year Filed)

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

29/133,861

12/08/00

Patented

(Application Serial No.) (Filing Date) (Status: Patented, Pending or Abandoned)

I hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below:

60/306,743

07/20/01

Pending

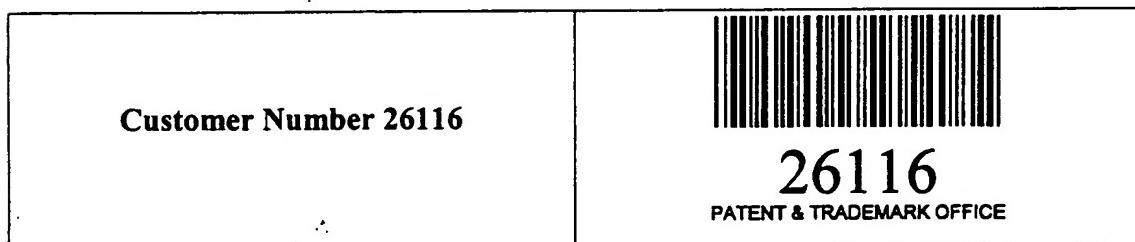
(Application Serial No.) (Filing Date) (Status: Patented, Pending or Abandoned)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

POWER OF ATTORNEY: I (We) hereby appoint as my (our) attorneys, with full powers of substitution and revocation, to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

<u>Attorney</u>	<u>Reg. No.</u>	<u>Telephone No.</u>
Hugh A. Abrams	31,937	312-853-7017
Richard A. Cederoth	31,336	312-853-7026
Douglas I. Lewis	39,748	312-853-4169

As named inventors, we hereby also appoint the practitioners associated with Customer Number 26116 as my/our attorneys or agents to prosecute this application and to transact all business in the United States Patent and Trademark Office connected therewith, and direct that all correspondence be addressed to the address associated with that Customer Number.



Direct Telephone Calls to:

Hugh A. Abrams
Sidley Austin Brown & Wood
Bank One Plaza
10 South Dearborn Street
Chicago, Illinois 60603
Telephone: (312) 853-7017
Facsimile: (312) 853-7017

Direct Correspondence to: Customer Number 26116

Name of First or Sole Inventor: DAVID W. NELMS

Citizenship: United States

Residence Address-Street: 620 South Broadmore Drive

POST OFFICE
Address-Street

620 South Broadmore Drive

City, State (Zip): Lake Forest, IL 60045

City, State (Zip): Lake Forest, IL 60045

Country: United States

Country: United States

Date: 10/31/02

Signature: David Nelms

Name of Second Inventor: BETTY M. SCHICK

Citizenship: United States

Residence Address-Street: 38924 N. Cedar Valley Drive

POST OFFICE
Address-Street

38924 N. Cedar Valley Drive

City, State (Zip): Lake Villa, IL 60046

City, State (Zip): Lake Villa, IL 60046

Country: United States

Country: United States

Date: 10/31/02

Signature: Betty M. Schick

Name of Third Inventor:	Citizenship:
<u>KIMBERLY S. WILSON</u>	<u>United States</u>
Residence Address-Street:	POST OFFICE Address-Street
<u>916 Judson Avenue</u>	<u>916 Judson Avenue</u>
City, State (Zip):	City, State (Zip):
<u>Highland Park, IL 60035</u>	<u>Highland Park, IL 6035</u>
Country:	Country:
<u>United States</u>	<u>United States</u>
Date:	Signature:
<u>10/31/02</u>	<u>Kimberly Wilson</u>
Name of Fourth Inventor:	Citizenship:
<u>ROGER C. HOCHSCHILD</u>	<u>United States</u>
Residence Address-Street:	POST OFFICE Address-Street
<u>7 Evergreen Lane</u>	<u>7 Evergreen Lane</u>
City, State (Zip):	City, State (Zip):
<u>Larchmont, New York 10538</u>	<u>Larchmont, New York 10538</u>
Country:	Country:
<u>United States</u>	<u>United States</u>
Date:	Signature:
<u>11-3-02</u>	<u>Roger Hochschild</u>